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OFFICE OF PETITIONS

In re Patent No. 7,346,216 : DECISION ON REQUEST
Adachi et al. : FOR RECONSIDERATION
Issue Date: March 18, 2008 : OF
Application No. 10/658,190 : PATENT TERM ADJUSTMENT
Filed: September 10, 2003 :
Atty Docket No. 9683/259 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(d)," filed May 9, 2008. Patentees request that the patent term adjustment indicated on the patent be corrected from seven hundred sixty (760) days to one thousand two hundred twenty (1220) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

OPINION

On March 18, 2008, the above-identified application matured into U.S. Patent No. 7,346,216, with a revised Patent Term Adjustment of 760 days. The instant request for reconsideration filed May 9, 2008 was timely filed within 2 months of the date the patent issued. See § 1.705(d). Patentees assert three bases for correction of the patent term adjustment: 1) 257 days for Office delay between the time of the mailing of the Restriction Requirement and the time of the mailing of the Notice of Allowance, 2) 203 days for Office delay between the time of the

mailing of the Notice of Allowance and the time the patent issued, and 3) 460 days for the Office delay beyond the three year date.

On First Basis

With respect to the first basis, this contention is dismissed as untimely. As stated in 37 CFR 1.705(d),

any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

The initial determination of patent term adjustment mailed with the notice of allowance includes calculation of all periods of adjustment and reduction for Office and applicant delay up to and including with the mailing of the notice of allowance. Thus, it includes any Office delay in mailing the notice of allowance. As this contention challenges the patent term adjustment indicated on the notice of allowance, it should have been raised on application under 37 CFR 1.705(b) filed prior to payment of the issue fee.

In this case, an application for patent term adjustment under 37 CFR 1.705(b) was timely filed on November 27, 2007, requesting that a period of reduction of 50 days for applicant delay be corrected to 4 days. It did not raise any other issue. Further, after an evaluation of all delays in this application, by decision mailed February 5, 2008, the application for patent term adjustment was granted and the period of reduction corrected from 50 days to 4 days (for a total determination of patent term adjustment at the time of the mailing of the notice of allowance of 760 days). The corrected patent term adjustment did not include any further period of adjustment for Office delay in mailing the notice of allowance. No request for reconsideration of this decision on application for patent term adjustment was filed.

Regardless, it is appropriate to advise patentee that there is no basis in the rules for according Office delay for the period of 257 days from the mailing of the Restriction Requirement to the mailing of the Notice of Allowance.

On Second Basis

Likewise, with respect to the second basis for correction of the patent term adjustment, patentee is advised that there is no basis in the rules for according Office delay for the period of 203 days from the mailing of the notice of allowance to the time the patent issued. 37 CFR 1.702 sets forth the grounds for entering periods of adjustment due to examination delay (Office delay). Patentee does not indicate proper grounds for entry of 203 days for Office delay. After the mailing of the notice of allowance, applicant delay is at issue. In response to the notice of allowance, applicant not the Office next takes action. Applicant must pay the issue fee and satisfying all other outstanding requirements before the Office can issue the patent. Thus, after applicant takes action, Office delay is at issue. Specifically, 37 CFR 1.702(a)(4) provides for entry of a period of adjustment for Office failure to:

Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

In this case, the issue fee and all outstanding requirements were satisfied as of November 27, 2007. As the patent issued within four months, on March 18, 2008, there was no Office delay within the meaning of 37 CFR 1.702(a)(4).

On Third Basis

Patentee asserts that the delay beyond the three-year date is properly accounted for as 460 days. It is not clear how patentee determined a period of adjustment of 460 days (or thus, argues that the patent term adjustment should be increased by 460 days from 760 days to 1,220 days).

With respect to §1.703(b), it is noted that the patent issued three years and 555 days after its filing date. However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and

not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, it was properly concluded that the 764 days accorded pursuant to 1.702(a)(1) for Office delay during the pendency of the application overlapped with the 555 days pursuant to 1.703(b). Thus, no additional periods of adjustment was entered for Office delay in issuing the patent.

Conclusion

In view thereof, the patent term adjustment of 760 days indicated in the patent is correct.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required. Patentee submitted a payment of \$400; the overpayment of \$200 is being credited to Deposit Account No. 23-1925, as authorized.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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